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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/520,087 03/07/00 SCOTT

V SG 99428

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| EXAMINER |
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| GUADALUPE, V | |
| ART UNIT | PAPER NUMBER |

2859
DATE MAILED:

04/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/520,087

Applicant(s)

SCOTT ET AL.

Examiner

Yaritza Guadalupe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/7/00.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 6 and 10 are rejected under 35 U.S.C. 102 (b) as being anticipated by Idan (US 4,665,622).

Idan discloses an optical sighting device comprising an elongated housing (10), a lens (110) located at one end of the light channel and having a partially reflective surface (See Column 6, lines 2 – 5), a laser diode (32) for emitting light toward said reflective surface to produce a light spot by direct imaging of the laser diode on said reflecting surface and wherein the light spot is being superimposed on a target when sighting through the light the light channel (See Column 6, lines 20 – 28), a battery (B) for providing electric current, and an energizing circuit (33) for energizing the laser diode and operable to apply a pulsating electric current from said battery to said laser diode source. Idan also discloses a control means (24) provided for energizing the laser diode when a weapon (14) to which said optical sight is mounted is to be used and for automatically reducing energization of the laser diode in dependence of a predetermined condition and for adjusting the intensity of the light spot and a pulse width

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modulation of the laser diode source (See Column 4, lines 54 – 64). Idan discloses a manually operated switch (16) for energizing the laser diode. Idan discloses a sensor for detecting the presence of ambient light for energizing the laser diode at lightness and reducing the energizing of the laser at darkness (See Column 3, lines 37 – 41).

With respect to the preamble of the claims : the preamble of the claim has not been given any patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self – contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 8 – 9 and 11 - 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Idan (US 4,665,622).

Idan discloses an optical sighting device as stated in paragraph 3 above.

Idan does not disclose the motion sensor as stated in claim 8, the sensor for detecting orientation of the weapon as stated in claim 9, the sensor for detecting the presence of an eye looking through the sight as stated in claim 11, and the sensor for detecting a phenomenon associated with a human being as stated in claim 12.

Regarding claims 8, 9, 11, and 12 : Idan discloses a sensor for detecting the presence of ambient light as part of the control means as stated above. The use of the particular type of sensors / detectors claimed by applicant, i.e., motion sensor, orientation sensor, sensor for detecting the presence of an eye looking through the sight, and a sensor for detecting a phenomenon associated with a human being, absent any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the laser diode can be energized as a response to the detected signal, as already suggested by Idan, 2) the sensors / detectors claimed by Applicant and the sensor / detector used by Idan are well known alternate types of sensors / detector which will perform the same function, if one is replaced with the other, of energizing the laser diode as a response to the detected signal, and 3) the use of the particular type of sensors / detectors by

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Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of sensors / detectors that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to energize the laser diode as a response to the detected signal as already suggested by Idan.

With respect to claim 13 : Idan discloses the use of an LED as the light source for emitting a light beam (See Column 4, line 41) but does not specify the particular value for the wavelength used for the light emitted from the source. However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the wavelength of the light emitted having a value the range of 630 nm – 700 nm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the “optimum range” involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Idan (US 4,665,622) in view of Bindon et al. (US 5,924,234).

Idan discloses an optical sighting device as stated in paragraph 3 above.

Idan does not disclose the time – out circuit as stated in claim 7.

With respect to claim 7 : Bindon et al. discloses a sighting device comprising a LED (32) having a control means that is manually or electronically controlled (See Column 2, lines 55 –

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56), the electronically controlled being considered a time – out circuit since a predetermined period can be pre – set in order to operate (energized / de-energized) the device. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide an electronically controlled means / time – out circuit as part of the control means as taught by Bindon et al. in the apparatus disclosed by Idan since the addition of operative commands to an electronic control means is well known in the art particularly if it is desired to manipulate the period of energizing or operating a device as taught by Idan and Bindon et al.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ford (US 5,351,429) discloses a laser sighting device comprising a housing (52), a laser diode (92), a lens (96), a switch (86), a battery (64), and a circuit control means (See Column 5, lines 59 – 62). Wallace et al. (US 6,061,945) discloses an optical system comprising an elongate housing (30), and a lens (24). Clarkson (US 5,901,452) discloses a sight comprising a laser diode (32) energized by a battery and having an intensity modulation switch (See Column 6, lines 36 – 38), a lens (24) having partially reflecting surface (40).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe whose telephone number is (703)305 -5676. The examiner can normally be reached on 8:00 AM - 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7722 for regular communications and (703)308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.



Y. Guadalupe
April 23, 2001

DIEGO F.F. GUTIERREZ
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